

Application No.: 09/841,475**Atty Docket: FATB 1000-1****REMARKS**

Claims 1-22 and 27-56 are currently pending in this application. The Examiner has rejected claims 1-22, 27-32 and 34-56 and has objected to claim 33.

Claims 1-29, 32, 34-51 and 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier (U.S. Patent No. 6,480,885, hereafter "Olivier"). Claims 30-31 and 52 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier, as applied to claims 1-29, 32, 34-51 and 53-54, in further view of Stirpe et al. (U.S. Publication No. 20020087496, hereafter "Stirpe"). Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

Technology Tutorial and Interview Request

There are very broad differences between the technology disclosed and the references cited, which are being overlooked in the selection of sound bites from the references. The Olivier reference is not really very close to the claimed subject matter.

Applicants request an interview, augmented with WebEx, to elaborate on the technology tutorial that follows. This interview should be scheduled a few days in advance, to assure that the WebEx tool (hmbay.webex.com) works properly.

This disclosure discusses collection of data using one or more client-side modules that monitor certain user activities, such as navigating to web sites or visiting physical locations with a location-aware electronic device in hand. The user selects particular individuals from their buddy list to whom the collected data can/may be published. See FIG. 8A. The user selects categories of information to share with particular individuals. Because the individuals are on the user's buddy list, we expect that they often will be friends well-known to the user. The system allows users to be selective in what they share with which particular friends. Once the configuration is complete, the system automatically publishes the user's selected activities to the selected buddies, without further effort by the user. In FIGS. 9 and 16, the Examiner can see how automatically collected data might later be viewed by informal networks of buddies. One can imagine future claim sets that will cover the publication/viewing process, as opposed to the data collection addressed by the current claims.

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Olivier is a tool for managing e-mail group lists, like Yahoo groups. Olivier's tool allows a user to send an e-mail to the group list management server and parametrically describe who might be interested in receiving a copy of the e-mail. Olivier's figures 1 and 9 illustrate geographic targeting using parametric descriptions. Figure 1 uses a map to illustrate geographic targeting. Figure 9 shows criteria coding that includes a distance of 5 miles for soliciting singers to meet in a park. Olivier's system is not designed to give the user access to the group membership list. Olivier's user does not select individuals or friends. Olivier's user sets criteria for each e-mail to be applied the group list management server. The group list management server, not the user, selects group members who meet the criteria. The persons selected are unknown to the user. "By dynamically matching each user's profile data and acceptance criteria to others, the system creates a customized group for each user, enabling groups to form automatically." Col. 3, lines 65-67. Each time anything is to be shared, the user needs to send an e-mail message with the shared content and a parametric definition of the intended audience.

In an interview, Applicants would like to discuss these descriptions of the disclosure and Olivier. We frankly do not see any similarity between the two.

Rejection Under 35 U.S.C. § 103(a) of Claims 1-22, 27-29, 32, 34-51 and 53-54

The Examiner again rejects **claims 1-22, 27-29, 32, 34-51 and 53-54** under 35 U.S.C. § 103(a) as unpatentable over Olivier [U.S. Pat. No. 6480885].

Claims 1, 19 and 27

We appreciate that the Examiner has withdrawn rejection of claim 1 over Stripe.

Claims 1, 19 and 27 include the limitations:

1. ... registering a user with a registration server to collect and share tracking data corresponding to at least a portion of the user's computer usage experiences wherein the computer usage experiences include one or more of browsing URLs or visiting a location with a location-aware device that records the visited location;

accessing one or more of the user's messaging buddy lists to identify one or more buddies with whom the tracking data may be shared;

defining rights of the buddies to access the tracking data;

tracking at least a portion of the user's computer usage experiences and reporting the tracking data to a tracking server;

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19. The method of claim 1, wherein the user utilizes a computer and tracking is carried out by a module resident on the computer.

27. The method of claim 1, wherein the computer usage includes sending tracking data regarding one of a user's computer usage experiences to one or more buddies.

These limitations are not found in Olivier. What Olivier teaches is group e-mail management system, to which e-mails are sent.

The Examiner again concedes that Olivier does not teach automatically tracking *the user's computer usage experience*.

Olivier does not specifically teach that the sharing includes computer usage experiences including one or more of browsing URLs, downloading files or visiting a location with a computer device that records the visited location. [¶] However, since Olivier's system is open of any topic that could be emailed through a network, it is obvious that the computer usage experiences could also be a sharing topic among the users, because sharing computer usages, such as "how to browse the Internet" is a subject of common interest [co1.18, lines 5-17].

(FOA 3) The Examiner further argues,

[¶] It is noted that the server of Olivier's system collects and traces base user profile data, including computer experience level [co1.18, lines 9-11] \ record in a database [co1.7, lines 29-38; co1.9, lines 18-29], and shares information through, e.g., via message posting [co1.25, lines 1-51 among selected registered members. This is a clear indication that the prior art of Olivier reads on claim 1.

(FOA 10, point 1). In sum, the Examiner argues that either the user sending an e-mail or the user supplying profile information during registration reads on the claims.

The Examiner's arguments do not read on claim 1. There is no registration to collect and share tracking data. What Olivier's user registers for is membership in an e-mail group list management system, which sends e-mails to group members. Olivier's user does not register for automatic tracking of their own computer usage experiences.

There is no tracking of either browsing of URLs or visits to locations with a location-aware device that records the location visited. This is not in Olivier and not argued by the Examiner.

There is no accessing of a buddy list, as Olivier discloses sending e-mail to an e-mail group list management server, not to a user's buddies.

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There is no identification of buddies with whom tracking data may (in the sense of rights management) be shared, as Olivier is designed for parametric and categorical identification of potential recipients and dynamic formation of groups that match the parameters or categories. See, Olivier figure 9.

There is no user defining rights of buddies to access the tracking data. Olivier's user publishes e-mails, not automatically tracked data about a user's computer usage experience. Olivier's user defines sharing on an e-mail-by-e-mail basis, not on a buddy-by-buddy basis, because Olivier's recipients are dynamically selected by the server, on behalf Olivier's sender.

There is no posting of tracking data, only of e-mails.

There is no posting of tracking data according to defined rights of buddies to access the tracking data.

There is no overlap between Olivier and claim 1. Therefore, claim 1 should be allowed.

Regarding claim 19, Olivier does not use a module resident on the user's computer to track navigation to URLs or visits to physical locations. Therefore, claim 19 should be allowed.

Claim 27 adds to claim 1 sending tracking data to a buddy, explicitly, in addition to collecting the tracking data. This is like sending an e-mail to a specific individual (not a group list manager), in combination with the other limitations of claim 1. This claim highlights the stark differences between the approach taught in this disclosure and by Olivier.

In summary, claims 1, 19 and 27 should be allowable over Olivier.

Claims 2-3

Claims 2-3 include limitations describing alternate configurations of registration and tracking servers. Applicants do not find any tracking server, as that term is used in these claims, in Olivier. The Examiner argues (FOA 10-11, point 2) that the database and matching servers can be considered tracking servers. This does not meet the limitation "tracking server", as claim 1 requires that the tracking server receive tracked data (as distinguished from e-mails) representing navigation to URLs or visits to physical locations. Receiving tracking data is what makes it a "tracking server".

Therefore, claims 2-3 should be allowable over Olivier.

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Claims 4-7 include the the limitations:

- 4. The method of claim 1, wherein registering the user excludes collection of the user's e-mail address.*
- 5. The method of claim 1, wherein registering the user excludes collection of the user's actual name.*
- 6. The method of claim 1, wherein registering the user excludes collection of the user's physical address.*
- 7. The method of claim 1, wherein registering the user excludes collection of any information that identifies a user in a manner adapted to direct marketing.*

These limitations are contrary to Olivier's disclosure. Olivier expressly teaches, in a passage cited by the Examiner, "Upon providing profile data such as name, address, email address, age, and occupation, the server stores the base user profile data record in the database." Col. 9, lines 23-26. This statement is objective evidence that Olivier does not motivate one of skill in the art to meet the limitations of claims 4-7, which exclude collecting the data that Olivier teaches one to collect. Applying *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) and MPEP § 2143.01, there is not evidence of record to support the Examiner's argument that one of skill in the art would be motivated to modify Olivier as claimed, so rejection under § 103(a) is unfounded.

The Examiner argues (FOA 4) that Olivier teaches other means of protecting a user's privacy. "It would have been obvious to one of ordinary skill in the art that for privacy reasons one do not need to reveal his real name, address, and email address in Olivier's registration process." (FOA 11, point 3) For claims 4 and 7, since Olivier is an e-mail group list manager, it is not plausible that one of ordinary skill in the art would not collect the user's e-mail address. Therefore, claims 4 and 7 should be allowable.

For claim 5-6, the claimed negative limitations are suggested by the Examiner, not by Olivier. (FOA 4 & 11) The Examiner uses the claimed limitations as a blueprint or roadmap for modifying Olivier, contrary to Olivier's express teaching, without any teaching or suggestion to modify the reference by adding what the Examiner considers "well-known". This approach is prohibited by the "as a whole" rule of Section 103 and is

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sometimes called hindsight. The Federal Circuit explained in *Ruiz v. A.B. Chance*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d (BNA) 1686 (Fed. Cir. 2004):

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355- 56 (Fed. Cir. 1998).

See, *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337, 75 U.S.P.Q.2d (BNA) 1051 (Fed. Cir. 2005) (reciting *Ruiz* rule; "simply identifying all of the elements in a claim in the prior art does not render a claim obvious"). The Federal Circuit has rejected the Examiner's approach, both as a matter of evidentiary principle (*In re Lee, supra*, 277 F.3d at 1342-44, 61 USPQ2d at 1433-34; *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997)) and because the Examiner's reasoning used is prohibited by statute (*Ruiz; Princeton Biochemicals*).

Therefore, claims 4-7 should be allowable over Olivier.

Moreover, we previously argued on p. 14 that at least some of the Examiner's proposed modifications to Olivier would impermissibly change the principle of operation for Olivier's "method for enabling users to exchange group electronic mail by

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establishing individual profiles and criteria, for determining personalized subsets" of email mailing lists and would render Olivier unsuitable for its intended purpose. We cited the MPEP § 2143.01 and the relevant cases. The Examiner did not respond or even acknowledge these important legal principles. (FOA 9-10)

Again, claims 4-7 should be allowed.

Claims 8-9

Claims 8-9 include the limitations:

8. The method of claim 1, wherein registering the user further includes establishing an anonymous unique identifier for the user.

9. The method of claim 8, wherein reporting the tracking data includes reporting the anonymous unique identifier.

Again, the limitation of claim 8 is directly contrary to the teaching of Olivier, col. 9, lines 23-26. ***Olivier is an e-mail list server that is based on e-mail addresses, not anonymous unique identifiers!*** The examiner responds (FOA 11, point 3) that Olivier protects privacy, but the argument falls short of teaching or suggesting the limitations of claim 8. As for claim 9, Olivier does not report of tracking data to a tracking server using an anonymous identifier. In the Examiner's response, it is the Examiner, not the reference, which suggests modifying Olivier, which is impermissible hindsight. *Ruiz v. A.B. Chance, supra*, 357 F.3d at 1275; *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., supra*, 411 F.3d at 1337.

Therefore, claims 8-9 should be allowable over Olivier.

Claims 10-15

Claims 10-15 specify the IM client that maintains the buddy list. These limitations are not found in Olivier.

Addressing claims 10-15, the Examiner comes close (FOA 11, point 4), but doesn't quite cite the part of Olivier that explains how Olivier would apply his technology to instant messaging systems such as those named in these claims. The most relevant passage spans columns 23-24:

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Another alternative embodiment for the present invention is instant messaging. Instant messaging services such as ICQ, "Yahoo! Pager", AOL Instant Messenger, and Excite PAL allow a user to send another user an immediate text message that pops up on the other user's screen while the user is connected to the messaging system. This is typically
5 when they are connected to the internet and running the messaging client application. Instant messaging applications do not as of yet have the equivalent of electronic mailing lists, i.e., a way to send an instant message to a group of users. Applying the present invention to instant messaging requires no change to the subscription. An additional user
10 interface component in the instant messaging software or on a web page allows the user to see a list of all matching users who are logged on. This happens within the context of a subscription to a particular forum. The user may then choose to send a message to any one user on that list. Sending of
15 messages to an entire matching group is routed through the service provider's instant messaging server, which determines which message recipients will receive the message. It then distributes the message to those recipients. As an example of its use, a user may have two subscriptions set
20 up—she wants to hear from all neighbors within five blocks from her about for sale items, and all neighbors within one block of her about emergencies.

From this passage, we can see that Olivier does not intend to use buddy lists at all, but to "see a list of all matching users who are logged on" in the context of subscription to a particular forum, dynamically selecting forum members users based on their group membership and a selection criteria, with no mention at all of buddy lists.

The Examiner is mistaken in identifying this as a mutual agreement mechanism. Those familiar with forums will recognize that you register for the forum, not to publish tracking data to individuals who also belong to the forum.

Therefore, claims 10-15 should be allowable over Olivier.

Claims 16-18

Claims 16-18 include the limitations:

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wherein the rights of the buddies are defined by content category of the user's computer usage.

wherein the rights of the buddies are defined by appearance of one or more keywords on pages corresponding to URLs viewed.

wherein the rights of the buddies are defined by activity type of the user's computer usage.

The Examiner concedes that these limitations are not found in Olivier. (FOA 5) Nonetheless, the Examiner argues (FOA 5-6 & 11, point 5) that defining groups on an e-mail list server is equivalent to defining rights for buddies. The Examiner seems to reason that setting criteria for dynamically creating groups is equivalent to rights management for people listed in a buddies list. From a technical perspective, rights management and opting into interest groups are undeniably different technologies. In Olivier, opting into an interest group by declaring profile attributes (which are not policed) gains a recipient access to matching e-mails without any control by the sender, other than directing the e-mail to those interested. In Olivier, as previously established, there is not any use of buddy lists and not any selecting or defining rights of buddies. The passages cited do not read on the particulars of claims 16-18.

Therefore, claims 16-18 should be allowable over Olivier.

Claim 20

Claim 20 includes the limitations:

wherein the tracking is carried out by a device placed between a computer utilized by the user and an access point to the Internet.

Applicants previously challenged the Examiner's statement of what is well-known, because it is imprecise and does not meet the claim limitations. Applicants required the Examiner, under MPEP § 2144.03, to present evidence such as a publication or an affidavit, rather than the Examiner's assertion of what is well known.

The Examiner responded (FOA 12, point 7) by invoking "paragraph 51 of Chen, *et al.* [U.S. 20030054810 A1] for the function of a proxy server." Now the Examiner is combining Olivier and Chen, but has not described the combination in a manner that would read on the claim and has not provided a motivation to combine the references in the manner claimed.

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Moreover, Chen is not available as a reference, because this application was filed well before Chen and the Examiner has made no effort to prove a priority date earlier than Chen's filing date – priority is not automatic from either a continuation-in-part or conversion of a provisional filing.

Applicants defer making more arguments regarding Chen until the Examiner makes a *prima facie* showing that Chen is available as a reference, that Chen teaches the particular type of tracking claimed and that there is an evidentiary basis for a motivation to combine Chen with Olivier.

As Chen has not been properly combined with Olivier, claim 20 should be allowable over Olivier.

(Claims 23-26 were cancelled in the last response, which mooted FOA point 6, at 12, before the Examiner made the point.)

Claims 28-29

Claims 28-29 include the limitations:

further including categorizing at least a portion of the tracking data by content and sorting the tracking data by content category.

further including categorizing at least a portion of the tracking data by content and making the tracking data searchable by content category and date range.

These limitations are not found in Olivier.

In our prior response, we demanded an Examiner's affidavit or other objective evidence. The Examiner points to Olivier figure 4 (FOA 12, point 7) and argues,

categorizing at least of a portion of tracking data is performed at the time when a user selects a group to join by clicking either on the subject button [e.g., 414, Fig.4] or entering search key words [e.g., 416, Fig.4]. It is further noted that the claim languages use "tracking data" instead of "tracked data", therefore the categorizing tracking data can occur at the time a subgroup is defined or being selected.

Joining a group is not categorizing or sorting "the tracking data". Olivier processes e-mail messages, not tracking data as claimed, which includes "*one or more of browsing URLs or visiting a location with a location-aware device*". Categorizing tracking data is not the same as accepting e-mail messages with parametric destination

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profiles.

Therefore, claims 28-29 should be allowable over Olivier.

Claim 32

Claim 32 includes the limitations:

wherein posting further includes indexing text portions of at least a portion of pages reported from tracking the user's Internet usage

These limitations are not found in Olivier.

Olivier does not track a user's navigation to URL or report pages from tracking the user's Internet usage. Therefore, Olivier does not collect and index the pages visited by the user.

The Examiner argues that Olivier creates web pages for e-mails sent to the e-mail list server and makes them searchable. (FOA 12, point 9) E-mail messages are not pages reported from tracking the user's Internet usage or browsing to URLs. E-mail messages are not ordinarily referred to as "pages", it seems to us. Therefore, the Examiner's argument does not read on claim 32, much less Olivier doing what is claimed.

Therefore, claim 32 should be allowable over Olivier.

Claims 34-51 and 53-56

Claims 34-51 and 53-56 include limitations that we discussed above in the context of claims 1-29 and 32. These claims should be allowable over Olivier for at least the same reasons as the claims that they resemble.

Rejection Under 35 U.S.C. § 103(a) of Claims 30-31 and 52

The Examiner rejects **claims 30-31 and 52** under 35 U.S.C. § 103(a) as unpatentable over Olivier [U.S. Pat. No. 6480885] in view of Stripe et al [U.S. PGPub 20020087496].

Stripe is a distance learning tool that includes whiteboard features for annotating web pages. See, Stripe [0003] and [0030].

We question why the Examiner considers Olivier and Stripe to be in the same field of endeavor. To us, e-mail group list management and long distance learning do not seem to be the same field of endeavor, for purposes of selecting the references to try to combine.

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Claims 30-31 and 52

Claims 30-31 include the limitations:

wherein posting further includes providing annotation tools for associating notes with individual tracking data entries.

wherein posting further includes providing annotation tools for associating ratings with individual tracking data entries.

Claim 52 includes limitations similar to claim 31. The Examiner concedes that these limitations are not found in Olivier.

The Examiner cites Stripe [0030]:

[0030] The knowledge exchange system may include an annotation service that allows the trainer or author to annotate web pages during live, self-paced or archived presentations. The annotation service may support the ability for the trainer or trainers to draw on their local computer screens and those drawings, mark-ups or annotations are rendered to one or more recipients. This allows the trainer to highlight portions of the knowledge component, to provide such features as dynamically underlining items, drawing on slides, circling items. The annotation service may provide similar capabilities as the White Board tool, except the annotation service may but is not limited to annotating the web pages that are or have been pushed to the recipients. Thus, the annotation service may be more tightly coupled with the Page Flip service.

Stripe's annotation tool is not adapted to associating notes or ratings with individual tracking data entries (e.g., rows of data), as claimed.

Of course, Applicants have not invented computer-based drawing or annotation tools. Such generalized overlay and annotation tools do not associate notes or ratings with individual tracking data items, which appear in tables, many items to a page. A tool that annotates web pages, as Stripe does, is not powerful or granular enough to meet the claimed limitations, especially as data rows are resorted or presented to different buddies in different combinations. Therefore, the proposed combination is not a proper basis for rejecting the claims.

For motivation, the Examiner argues,

It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to also provide an annotation and rating capabilities to Olivier's subscribers because it is common to have various comments during the "discussion" and an annotation tool would facilitate the group members to add additional information (such as rating of a topic or a concerned product) onto the original information.

This motivation comes from the Examiner, not either of the references, and therefore is impermissible hindsight. *Ruiz v. A.B. Chance, supra*, 357 F.3d at 1275; *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., supra*, 411 F.3d at 1337. Even if the combination read on the claims, which it does not, the combination would be improper.

The Examiner's motivation is not persuasive, based on common experience with posting boards. Allowing readers to mark postings with graffiti is a problem to avoid, not a feature to introduce.

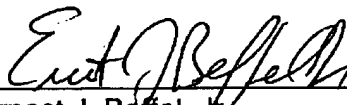
Applicants respectfully submit that claims 30-31 and 52 should be allowable over Olivier in view of Stripe.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,



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